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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/684,801

10/15/2003

Masahito Fujita

FUJITA11

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1444

7590

12/01/2004

BROWDY AND NEIMARK, P.L.L.C.

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/684,801

Applicant(s)

FUJITA ET AL.

Examiner

Sikyin Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 6 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Claim Rejections - 35 USC § 103**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5582281 to Nakashima et al in view of JP 09316570.

Nakashima in col. 2, lines 35-64 discloses the features including the claimed copper base alloy composition and hardness. The difference between the reference(s) and the claims are as follows: Nakashima does not disclose the dispersed Mn-Si compound and Bi particle, and prefer mixed phases ( $\alpha+\beta$ ) instead of single  $\alpha$ -phase. However, dispersion of Mn-Si and Bi is material property which would have been inherently possessed by the material (JP 09316570, [0016]). With respect to the single  $\alpha$ -phase that Nakashima in col. 3, lines 33-43 discloses  $\alpha$ -phase alone is less rigid. JP 09316570 teaches to reduce  $\beta$  to 30% or lower in order to improve cold workability. As are evinced by cited references that all phases related to Cu-Zn alloys are known and can be adjusted according to the desired properties by ordinary skill artisan; therefore, the claimed single  $\alpha$ -phase is considered as result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments filed September 15, 2004 have been fully considered but they are not persuasive.

Applicants' argument as set forth in paragraph bridging pages 9-10 of instant remarks is noted. But, applicants' argument is found inconsistent with instant transitional expression "comprising" as recited in instant claim 1, which is inclusive and fails to exclude unrecited ingredients even in major amounts. See *Ex parte Davis et al.* (POBA 1948) 80 USPQ 448 and *In re Bertsch* 132 F.2d 1014, 56 USPQ 379 (CCPA 1942). Moreover, the listing of numerous solutions (here elements) to a problem does not make any one solution less obvious. *Ex parte Raychem Corp.* 17 USPQ 2d 1417, 1424 (BPAI 1990) and *Merck & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (CAFC 1983). In *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990), the BPAI held that when a "species is clearly named, the species claim is anticipated no matter how many other species are additionally named." The Board said that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102 (a), in that publication". One of ordinary skill artisan would have been led to select the claimed elements, motivated by a reasonable expectation of successfully achieving cited references' objectives. The disclosed genus would have rendered the species *prima facie* obvious. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir 1989); and *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Applicants' argument from pages 10-12 of instant remarks is noted. But, Bi has been taught by Nakashima et al (see abstract and col. 2, lines 35-57). Furthermore,

there is no factual evidence that Bi has any effect on Mn-Si compound formation or Bi of cited reference would not be distributed throughout the matrix.

Applicants' argument with respect to JP '570 is noted. But, JP '570 is merely cited to show function of  $\beta$ . By reducing/eliminating  $\beta$ , the cold workability would be increase. It has been held that combining known ingredient (here  $\beta$  phase) having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962). Furthermore, Nakashima already discloses single  $\alpha$  phase (see col. 3, lines 34-43). It is well settled that the teaching of a reference is not limited to preferred embodiments. All disclosures of prior art, including unpreferred embodiments, must be considered in determining obviousness. See In re Boe, 148 USPQ 507, 510 (CCPA 1966), Ex parte Thumm 132 USPQ 66, 68, and In re Siebentbritt, 152 USPQ 618. Moreover, under 35 USC § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. In re Lamberti, 545 F.2d 747, 192 USPQ 278, 280 (CCPA 1976); In re Simon, 59 CCPA 1140, 461 F.2d 1387, 174 USPQ 114 (1972); and In re Mills, 470 F.2d 649, 176 USPQ 196 (CCPA 1972). Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc., 127 F.3d 1065, 1068, 44 USPQ2d 1336, 1339 (Fed. Cir. 1997) (error to construe prior art disclosure as limited to the preferred embodiment).

## **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

#### Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
November 29, 2004